



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,227	12/12/2003	Lawson C. Mitchell	PC-1563CIP	1858

23717 7590 07/28/2004

LAW OFFICES OF BRIAN S STEINBERGER
101 BREVARD AVENUE
COCOA, FL 32922

EXAMINER

GORDON, RAEANN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,227

Applicant(s)

MITCHELL ET AL.

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a golf device, classified in class 473, subclass 226.
- II. Claims 17-20, drawn to a method of using a golf device, classified in class 473, subclass 409.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the golf training device may be used by various methods.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian Steinberger on July 20, 2004 a provisional election was made with traverse to prosecute the invention of the golf device, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All claims, explain the term "planar". Claim 1, "twisted at a second angle" is not clear. Claim 2, which "plate" is being claimed (plate in the device or socket)? Claims 4, 5, 14, and 15, "concave" is at odds with specification page 12, which recites "convex". Please note this term is for the single plate and not the double plate embodiment. If the double plate is different from the single plate it should be noted in the specification, i.e., convex. Claim 11, the plates should be distinguished, i.e., first plate and second plate. The plate "bent and twisted at two different angles" is not clear or shown in the drawings. Specifically, the "twisted" portion and the "two different angles" are not understood. Claims 6 and 16, the attachment socket permanently affixed to the club is not understood. Is applicant attempting to claim the device is fabricated integral with the golf club? If so, the figures or

Art Unit: 3711

specification does not show a "socket" when the device is made integral with the club, only the plates are visible (see figure 13A). However, if applicant is stating the socket is permanently fixed to the club, the limitation should be added to the specification. Claim 13, which "plate" is being claimed (plate in the device or socket)? The first occurrence of the "attachment socket" should be deleted. The attachment means cannot comprise a attachment socket (see claims 11 and 12 for clarification). Claim 15, which "plate" is being claimed?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 11, 12, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall (5,976,024). Regarding claim 1, Marshall discloses an apparatus for golf comprising an attachment socket (25) and a single plate extending from the top of the socket. The plate is wider at the distal end and is capable of resting on a golfer's arm. The distal end is bent with respect to the end closest to the socket (proximal). Regarding claim 4, the plate has a curved shaped at the distal end. Regarding claim 6, the device is inherently capable of being permanent if it is not removed. Regarding claim 11, Marshall discloses an apparatus for golf comprising an attachment socket (25) and two plates extending from the top of the socket. The plates

Art Unit: 3711

are wider at the distal end and are capable of resting on a golfer's arm. The distal end is bent with respect to the end closest to the socket (proximal). Regarding claim 12, the device is removable from the golf club. Regarding claims 14 and 15, the plates have a curved shaped at the distal end. Regarding claim 16, the device is inherently capable of being permanent if it is not removed.

Claims 1, 4, 6, 8-12, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasquez (5,470,073). Regarding claim 1, Vasquez a golfing device comprising an attachment for attaching the device a golf club. The device further includes a single plate extending from the top of the attachment means comprising a first and second end (distal). The second or distal end is wider than the first end and is capable of resting on a golfer's arm. The distal end is also bent with respect to the first end. Regarding claim 4, the distal end has a curved shape. Regarding claims 8-10, Vasquez discloses the plates may be adjusted to any angle, therefore the device is capable of being positioned at the angles claimed by applicant. Regarding claim 11, Vasquez a golfing device comprising an attachment for attaching the device a golf club. The device further includes two plates extending from the top of the attachment means comprising first and second ends (distal). The second or distal end is wider than the first end and is capable of resting on a golfer's arm. The distal end is also bent with respect to the first end. Regarding claim 12, the device is capable of being removed from a golf club. Regarding claims 14 and 15, the plates are curved at the distal ends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Lin (6,398,663). Marshall discloses the invention as shown above but fails to teach a threaded collar as the attachment means. However, Lin teaches a golfing device comprising a threaded collar. One of ordinary skill in the art would have modified the attachment means for better security. With respect to claim 3, the device of Marshall is obviously either plastic or metal.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raeann Gordon
Primary Examiner
Art Unit 3711

rg
July 23, 2004